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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,931	08/25/2003	Young-Uk Ko	P56842	1757

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EXAMINER

NGUYEN, HUY D

ART UNIT PAPER NUMBER

2681

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,931

Applicant(s)

KO ET AL.

Examiner

Huy D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-6, 8-10, 12-14, 16-18, 20, 22, 23, 25-30 and 33 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 16-18, 27, 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 12, 20, 22, 25, 26, 28, 30 and 33 is/are rejected.
- 7) ☒ Claim(s) 2, 5, 6, 13, 14 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I in the reply filed on 8/29/2005 is acknowledged. In response to the arguments regarding the election/restriction requirement, the examiner contends that there is a serious burden for searching/considering both groups since considering the subcombination in group II with separate utilities such as "searching for a subscriber database of the private mobile communication system to determine whether the mobile communication terminal is registered or not and performing a location registration of the mobile communication terminal according to registration result" requires further search in subclass 435.2 in addition to subclass 426.1 which is required for group I.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 12, 20, 22, 25-26, 28, 30, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (US 2002/0022497).

Regarding claims 1, 4, 12, 20, 22, 33, Kim et al. teaches a method for providing a user with a private mobile communication service when a mobile communication terminal enters a private mobile communication network being interoperable with a public mobile communication

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network (see figure 2 and paragraphs [0048], [0049]), comprising the steps of: upon receiving a system parameter message being broadcast by the private mobile communication system, checking a predetermined bit for indicating the private mobile communication service area contained in the system parameter message; when the mobile communication terminal exists in the private mobile communication service area, transmitting a location registration message (e.g., call origination request message generated by the mobile station 44 in the public/private mobile communication network 40 is provided to the call manager 80 – see paragraph [0053]) including a predetermined registration type (e.g., public or private mobile communication request – see [0053]) to the private mobile communication system; receiving a message including a private mobile communication service associated command from the private mobile communication system according to registration result information of the private mobile communication system (e.g., sends a specific message to the private mobile system 22 – [0054]; and performing a command contained in the received message (see [0055]).

Regarding claims 25-26, 28, 30, Kim et al. teaches the method as set forth in claim 1, wherein the command allows the mobile communication terminal to perform a manner mode conversion function (e.g., frequency conversion, frequency down conversion to baseband – see [0054]).

Allowable Subject Matter

4. Claims 2, 5-6, 13-14, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Regarding claims 2, 5, 13, and 23, the closest prior arts, Kim et al., Qu et al. (US 2004/0203615 A1), and Kang (US 2001/0046214 A1), either singularly or in combination, fail to teach the method as set forth in claim 1, wherein the message including the private mobile communication service associated command is a feature notification message including a predetermined field used for indicating the private mobile communication service possible state.

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy D. Nguyen whose telephone number is 571-272-7845. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HN

Huy Nguyen


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER